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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/875,237	06/06/2001	Douglas F. Fry	U 0045 OS/TEAP	7303

23657 7590 05/27/2004

COGNIS CORPORATION  
PATENT DEPARTMENT  
300 BROOKSIDE AVENUE  
AMBLER, PA 19002

EXAMINER

SANDERS, KRIELLION ANTIONETTE

ART UNIT

PAPER NUMBER

1714

DATE MAILED: 05/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.	Applicant(s)
09/875,237	FRY ET AL.
Examiner	Art Unit
Kriellon A. Sanders	1714

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 March 2004.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-30 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 6,399,741. Although the conflicting claims are not identical, they are not patentably distinct from each other.
2. Applicant's claims 1-11 are directed to a polymer derivative that is fully described in patentees' claims.
3. Applicant's claim 1 recites a polymer derivative comprising a polyalkyleneimine backbone having a number of reactive amino functionalities, each reactive amino functionality having at least one reactive hydrogen atom, wherein about 20% to about 60% of the number of reactive amino functionalities have a substituent-compound substituted in place of the at least

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one reactive hydrogen atom each substituent-compound independently selected from the group consisting of carboxylic acids having from about 14 to about 20 carbon atoms.

4. Claim 1 of the patent recites A polymer derivative comprising a polyalkyleneimine backbone having a number of reactive amino functionalities, each reactive amino functionality having at least one reactive hydrogen atom, wherein a color stabilizing-effective amount of the number of reactive amino functionalities have a substituent-compound independently selected from the group consisting of carboxylic acids and amine-protecting compounds substituted in place of the at least one reactive hydrogen atom, and wherein at least about 20% of the reactive amino functionalities have a carboxylic acid substituted in place of the at least one reactive hydrogen atom.

5. Claim 4 of the patent recites that the carboxylic acids of claim 1 have from 2-18 carbon atoms.

It is clear that the polyalkyleneimine polymers of the patent overlap with those of applicant's claims.

the ordinary practitioner in this art would be able to determine that a color stabilizing effective amount of the number of reactive amino functionalities is between 20% and 60%. Fry et al at claim 1 indicates that a color stabilizing effective amount of the number of reactive amino functionalities have a substituent compound independently selected from the group consisting of carboxylic acids and amine protecting compounds substituted in place of the at least one reactive hydrogen atom. Applicant's claims require that 20% to 60% of reactive amino functionalities have a substituent compound independently selected from the group consisting of carboxylic acids and amine protecting compounds substituted in place of the at least one reactive hydrogen

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atom. The ordinary practitioner in this art would be able to determine that a color stabilizing effective amount of the number of reactive amino functionalities is between 20% and 60%. It is also within the skill of the ordinary practitioner in this art to select carboxylic acids having from 2-18 carbons in view of patentee's claim 21. Selection of palmitic and stearic acids would have been obvious to the art-skilled.

6. Applicant's arguments filed 3/10/04 have been fully considered but they are not persuasive.

7. Applicant's claim 1 recites a polymer derivative comprising a polyalkyleneimine backbone having a number of reactive amino functionalities, each reactive amino functionality having at least one reactive hydrogen atom, wherein about 20% to about 60% of the number of reactive amino functionalities have a substituent-compound substituted in place of the at least one reactive hydrogen atom each substituent-compound independently selected from the group consisting of carboxylic acids having from about 14 to about 20 carbon atoms.

8. Claim 1 of the patent recites A polymer derivative comprising a polyalkyleneimine backbone having a number of reactive amino functionalities, each reactive amino functionality having at least one reactive hydrogen atom, wherein a color stabilizing-effective amount of the number of reactive amino functionalities have a substituent-compound independently selected from the group consisting of carboxylic acids and amine-protecting compounds substituted in place of the at least one reactive hydrogen atom, and wherein at least about 20% of the reactive amino functionalities have a carboxylic acid substituted in place of the at least one reactive hydrogen atom.

9. Claim 4 of the patent recites that the carboxylic acids of claim 1 have from 2-18 carbon atoms.

Applicant states that about 20% to about 60% of the number of reactive amino functionalities have a substituent-compound substituted in place of the at least one reactive hydrogen atom

10. While patentee states that at least about 20% of the reactive amino functionalities have a carboxylic acid substituted in place of the at least one reactive hydrogen atom.
11. Patentees' claims include carboxylic acids having 16-18 carbon atoms.
12. Applicant's claims 12-22 are directed to a process for preparing a polymer derivative.
13. Patentee's claim 16 reads:

A process for preparing a polymer derivative, the process comprising (a) providing a polyalkyleneimine having a number of reactive amino functionalities per mole, (b) reacting the polyalkyleneimine with at least one carboxylic acid and an amine-protecting compound, wherein a total molar amount of the at least one carboxylic acid and the amine-protecting compound is used which is sufficient to derivatize a color stabilizing-effective amount of the number of reactive amino functionalities per mole.

This corresponds directly to applicant's claim 12.

14. Applicant's claims 23-28 are directed to a fiber lubricant.
15. Patentee's claims 36-40 recite:
36. A fiber lubricant composition comprising a polymer derivative according to claim 1.
37. A fiber lubricant composition comprising a polymer derivative according to claim 14.

38. A fiber lubricant composition comprising a polymer derivative according to claim 15.
39. A fiber lubricant composition comprising a polymer derivative according to claim 34.
40. A fiber lubricant composition comprising a polymer derivative according to claim 35.
16. Applicant's claims to fiber lubricants are encompassed by patentees' claims 36-40.
17. Applicant's claims 29 and 30 are directed to a method of lubricating a fiber as are patentees' claims 41-42.
18. The clear overlap in the claim limitations of the patented and present claims render applicant's invention obvious.
19. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kriellion A. Sanders whose telephone number is 571-272-1122. The examiner can normally be reached on Monday through Wednesday 8:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2351.



Kriellion A. Sanders  
Primary Examiner  
Art Unit 1714

ks  
May 25, 2004